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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,156	10/17/2001	Adrianne Lewis	1248-R-01	5615

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IP DEPARTMENT OF PIPER RUDNICK LLP
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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/981,156

Applicant(s)
Lewis

Examiner
James W. Myhre

Art Unit
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 30, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. The amendment filed on June 30, 2003 has been considered but is ineffective to overcome the Von Kohorn (5,916,024) reference.

Claim Rejections - 35 USC § 101

2. The amendment filed on June 30, 2003 has corrected the deficiencies noted in the 35 U.S.C. 101 rejection of Claims 18-36 in paragraph 2 of paper number 9. Therefore, the Examiner hereby withdraws that rejection.

Claim Objections

3. Claims 33-36 are objected to because of the following informalities: the amendment of June 30, 2003 amended the first line of each of these claims by replacing "template" with "computer readable medium of". However, this causes the claims to read "The computer readable medium of of claim 32" (emphasis added). The Applicant needs to delete one of the "of"s. Appropriate correction is required.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Kohorn (5,916,024).

Claims 1, 8, 13, 18, 25, and 32: Von Kohorn discloses a system, method, and computer program for advertising on a computer network, comprising:

- a. Incorporating one or more advertisements into an interactive game;
- b. Presenting an initial advertisement for the interactive game to one or more players over the network; and
- c. Allowing the player to play the game based on the player's interaction with the initial advertisement (col 1, line 25 - col 10, line 43).

The Examiner notes that Von Kohorn discloses that a plurality of products (i.e. advertisements) are presented to the user, who selects one of the products (col 79, lines 35-41) and is then directed to the game in order to "win" or qualify for some type of incentive for the selected product, such as a discount, coupon, free merchandise, etc. Since the product is selected prior to the user beginning to play the interactive game, the Examiner considers this to be the

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equivalent of the newly added “initial advertisement” in the amended claims. Von Kohorn also discloses that the game can consist of one or more additional advertisements being displayed to the user, who then responds to one or more queries about advertisement(s) in order to win the game.

Claims 2, 9, 19, and 26: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 25 above, and further discloses that the additional advertisement is an active element of the game (col 1, line 25 - col 10, line 43 and col 47, lines 11-15).

Claims 3, 10, 20, 27, and 34: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 26 and 32 above, and further discloses that the game is a trivia game and that the additional advertisement provides clues to the trivia questions (col 1, line 25 - col 10, line 43; col 43, lines 1-15; and col 119, lines 4-8).

Claims 4, 11, 21, and 28: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 27 above, and further discloses prompting the player to access advertisements on the advertiser’s website in order to progress in the game (col 1, line 25 - col 10, line 43).

Claims 5, 12, 22, 29, and 35: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 28, and 32 above, and further discloses providing one or more prizes to winning players (col 1, line 25 - col 10, line 43).

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Claims 6, 14, 15, 23, 30, and 36: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 13, 18, 29, and 32 above, and further discloses compiling demographic information on the player and targeting the advertisement based on the player's demographic information (col 1, line 25 - col 10, line 43).

Claims 7, 16, 24, 31, and 33: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 30, and 32 above, and further discloses that the game is one of a trivia game, bingo, dominoes, casino games, card games, tic-tac-toe, or jigsaw puzzle (col 1, line 25 - col 10, line 43 and col 119, lines 4-8).

Claim 17: Von Kohorn discloses a method for advertising on a computer network as in Claim 8 above, and further discloses placing the game into a computer advertising spot (col 1, line 25 - col 10, line 43).

Claims 37-40: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 25 above, and further discloses that the initial advertisement is accessible independent of accessing an advertiser's website. Von Kohorn explicitly discloses that the advertisements may be downloaded to the user's remote device prior to the user accessing the advertisement or game program. This downloading may be from online or through the use of a memory disk distributed to the user (col 29, lines 27-34; col 79, line 62 - col 80, line 7; and col 140, lines 59-67). Thus, when the user begins, an initial advertisement is presented to the user without necessitating the user connecting to the advertiser's website.

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Claim 41: Von Kohorn discloses a method for advertising on a computer network as in Claim 4 above, and further discloses that the advertising material is one of images of products, marketing messages, logos, taglines, and jingles (col 18, lines 23-29 and col 47, lines 9-19).

Response to Arguments

6. Applicant's arguments filed June 30, 2003 have been fully considered but they are not persuasive.

As discussed in the rejection of the amended claims above, Von Kohorn discloses presenting an initial advertising message to the user prior to the start of the interactive game. Since the user must select the desired product before the game play begins, the user's selection is a prerequisite for playing the interactive game.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

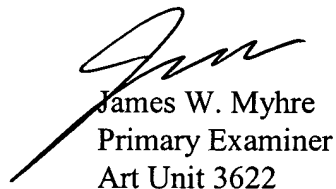
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM
August 12, 2003



James W. Myhre
Primary Examiner
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